



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087425,766	04/19/95	GREENE	R 617228-0115

BAKER & BOTTS  
2001 ROSS AVENUE  
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34M2/0625

EXAMINER  
TINKER, S

ART UNIT	PAPER NUMBER
3404	12

DATE MAILED:

06/25/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/425,766

Applicant(s)

Greene et al

Examiner

Susanne Tinker

Group Art Unit

3404



☒ Responsive to communication(s) filed on Mar 17, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-20 are rejected under the Recapture Doctrine as set forth in MPEP 1412.02.

A synopsis of the Recapture Doctrine and how it applies in this case follows

If a patentee tries to recapture what it previously surrendered in order to obtain allowance of original patent claims, that deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 USC 251 and is not an error of the kind which will justify the issuance of a reissue patent which included the matter withdrawn. The **recapture rule** bars a patentee from acquiring, through reissue, claims that are of the same scope or of broader scope than those claims that were canceled from the original application. In this regard, addition of narrowing limitations to a claim to overcome prior art is considered the full equivalent of cancellation of the claim and substitution of a narrower scope claim to overcome the prior art. See *Mentor Corp. V. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993).

However, the **recapture rule** will not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when the reissue claim is also narrower than the canceled claim in a way that is material to the "error" sought to be corrected by reissue. *Patacell v. U.S.*, 12 USPQ2d 1440 (U.S. Claims Court 1989). The recapture rule is based on the premise that when a patent applicant seeks to secure a patent by responding to a rejection of a claim by canceling or narrowing the scope of the claim, the applicant's intent is normally presumed. I.e., that the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable. It necessarily follows that a deliberate judgment that a claim is unpatentable would constitute a deliberate judgment that a broader claim is also unpatentable. But, when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee's intent and, therefore, as to the absence of "error" cannot be made exclusively on a comparison of the reissue claim with the canceled claim. The fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrower in some respect but broader in other respects also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim becoming patentable. Therefore, one cannot assume that when an applicant canceled a claim that the applicant made a deliberate judgment that a second claim that is narrower in a certain respect and of the same or broader scope than the canceled claim is also unpatentable.

Thus, when a reissue claim is narrower than the canceled claim in a way that is material to the alleged "error" supporting reissue, it is not possible to conclude from a comparison of claim scope alone that no "error" was involved in the patentee's failure to include a claim of the general scope of the reissue claim of the original patent. Based on this analysis, the Court of

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Claims held that where, as in this case, the reissue claim was not only broader in some aspects , but narrower than the canceled patent claim to which it corresponds **in a way that is material to the "error" sought to be corrected by reissue**, the recapture rule should not bar that reissue claim.

Applying these principles to the facts of this reissue application:

Applicant seeks to remove the following language from claim 1:

a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fire exhaust gases to reduce the quantity of CO, NO, and SO contained in said fired exhaust.

Applicant also seeks to remove similar language from claim 15, the only difference being the particular compounds removed from the exhaust gases.

However, the removal of this language is barred by the equitable "recapture" doctrine. In the patent sought to be reissued, the patentee argued that this claim language sought to be removed rendered the claims patentable over the prior art cited and applied in the rejection of those claims.

In the patent file, paper No. 5, filed August 19, 1991, on page 4, the patentee argued that the prior art failed to teach or mention a liquid filter arrangement as described and claimed by applicants, in that it did not mention a chemical treatment to reduce the quantity of CO, NO, SO, HCl or SO<sub>2</sub> as is required by applicant's claims

Additionally, the patentee amended claim 1, in paper No. 12, to distinguish over Hadley by adding "said" to modify "particulate matter" and by adding "fired" to change said "exhaust gasses" to "said fired exhaust gasses." The patentee also amended claim 22 to insert "filter" to change "liquid means" to "liquid filter means" and added "said" to modify "particulate matter" in the last clause of that claim. (NOTE: claim 22 in the patent file wrapper became claim 15 in the issued patent.)

Thus, applicant is seeking to "recapture" subject matter which was added to the claims to avoid the prior art. This is improper and cannot be permitted.

Furthermore, in the patent file in the Appeal Brief filed 10/29/92, applicant also argues the liquid filter element being a novelty of the patented invention which distinguishes it from the prior art. Examiner's "Reasons for Allowance" filed with the paper #20 specifically cites the liquid filter element as the subject matter rendering the claims allowable over the prior art of

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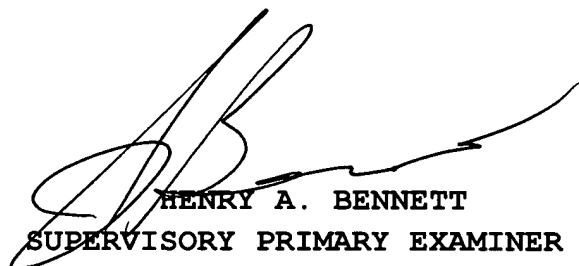
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record. No remarks from the applicant follow the examiner's statement of reasons for allowance and such lack of response is regarded as an agreement with the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanne Tinker whose telephone number is (703) 308-2637.

*SCT*  
SCT

June 23, 1997

  
HENRY A. BENNETT  
SUPERVISORY PRIMARY EXAMINER  
GROUP 3400